

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Jerry L. Brown	:	
	:	Examiner: Teskin, Fred M.
	:	
Serial No.: 10/708,026	:	Group Art Unit: 1713
	:	
U.S. Patent No: 7,091,309	:	
	:	
Filed: February 3, 2004	:	Attorney Docket No.: 713629.414
	:	
For: PROCESS FOR THE	:	
MANUFACTURE OF TEMPERATURE-	:	
SENSITIVE POLYMERS	:	Customer No.: 27128
	:	
	:	Confirmation No.: 2025

**PETITION UNDER 37 CFR 1.705(d)**  
**REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT**

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**INTRODUCTION:**

Applicant's Petition is to receive an additional ninety-one (91) days to the term of U.S. Patent No. 7,091,309, which is rightfully due Applicant, but denied because of an error of the United States Patent Office.

**Correct Patent Term Adjustment**

Applicant respectfully requests that the original Patent Term Adjustment (PTA) of 195 days previously granted with the Notice of Allowance be granted.

**STATEMENT OF FACTS:**

**Relevant Dates**

- JUNE 30, 2004 – A first *Office Action* was mailed by the Patent Office on June 30, 2004 within the fourteen months deadline.
- OCTOBER 15, 2004 – Applicant's filed *Amendment A* in response to the Office Action. A fifteen (15) day delay on the part of Applicant was incurred, since *Amendment A* was filed in excess of three months from the June 30, 2004 mailing date of the first *Office Action*..
- SEPTEMBER 13, 2005 – An *Office Action* containing a final rejection was mailed by the Patent Office. Based on the October 15, 2004 date upon which a timely response was filed by the Applicant's, a Patent Office delay of 210 days had occurred.
- DECEMBER 5, 2005 – Applicant's promptly file *Amendment B* in response to the Final Rejection. No delay occurred.
- DECEMBER 30, 2005 – A *Notice of Allowance* was promptly issued on December 30, 2005. A Determination of Patent Term Adjustment of 195 days was granted.
- MARCH 27, 2006 - The issue fee was timely paid by Applicant's filing via EFSWeb of a PTOL-85 "Fee(s) Transmittal" authorizing the Patent Office to charge Deposit Account 11-0160.
- JUNE 29, 2006 – The date of payment identified by the Patent Office as the date when payment of the issue fee was "verified".
- JULY 26, 2006 – The *Issue Notification* was mailed by the Patent Office incorrectly indicating a reduced patent term adjustment of 104 days.

On December 30, 2005, the *Notice of Allowance* contained a Determination of Patent Term Adjustment which correctly calculated that 195 days had accrued, based on the Patent

Office's failure to reply within four (4) months from the date the Applicant's response was filed<sup>1</sup>. The relevant dates to be considered are March 27, 2006 and June 29, 2006. On March 27, 2006, the Applicant timely submitted payment of the issue fee within the three month deadline. Attached as Exhibit A is the electronic acknowledgement receipt and Part B Fee(s) Transmittal Form as proof of timely payment.

The Patent Office apparently *incorrectly* calculated the date of payment of the issue fee as June 29, 2006, (the date upon which payment was "verified") which was counted as a 91 day reduction of the patent term adjustment from the 195 day granted in the *Notice of Allowance*. Consequently, the Patent Office incorrectly determined that only 104 days of patent term extension was appropriate.

#### Terminal Disclaimer

This Patent is not subject to any terminal disclaimer that would effect the expiration date of the patent.

### CONCLUSION

It is respectfully believed that there was not a delay caused by the Applicant in connection with the payment of the Issue Fee. This was not a continued examination, there was no interference proceeding, there was no secrecy order; there was no review by the Board of Patent Appeals and Interferences or a Federal court. Applicant were incorrectly penalized a term of 91 days under 37 C.F.R. 1.704(c)(3) for late payment of the issue fee, when in fact the issue fee was not paid late, but only "verified" as being paid by the Patent Office 91 days after payment was timely made by Applicant. As evidenced in Exhibit A, the issue fee was timely paid on March 27, 2006. Therefore, it is respectfully believed that substantially all of the delay was caused by the United States Patent Office.

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<sup>1</sup> The total delay of 210 days due to Patent Office delay was reduced by 15 days, due to Applicant's delay of 15 days in filing its *Amendment A* more than three months after mailing of the first *Office Action*.

Application of: Jerry L. Brown  
U.S. Patent No: 7,091,309  
Request for Reconsideration of Patent Term Adjustment

Although 37 C.F.R. Section 1.704(c) does recite late payment of the issue fee under verbiage that recites: "**Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances....**" However, it is respectfully submitted that there was absolutely no failure by the Applicant to conclude processing or examination, since the Issue Fee was, in fact, timely paid on March 27, 2006.

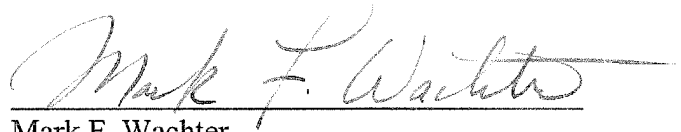
It is respectfully submitted that there were no circumstances that would properly constitute a failure by the Applicant to conclude processing. Applicant should be entitled to the full 195 day patent term adjustment as originally granted in the *Notice of Allowance*.

Applicant's attorney is enclosing the processing fee of \$200.00 set forth in §1.18(e) required for filing an application for patent term adjustment under 37 C.F.R. 1.705.

Therefore, it is respectfully requested that this Petition be granted. If a telephone conference would facilitate resolving any issue related to this Petition, the undersigned attorney would appreciate and welcome such a telephone conference. Contact information for this attorney is provided below.

Respectfully submitted,

Date: September 8, 2006



Mark F. Wachter  
Reg. No. 27,243  
Blackwell Sanders Peper Martin LLP  
720 Olive Street, Suite 2400  
St. Louis, MO 63101  
314-345-6000  
ATTORNEYS FOR APPLICANT

Application of: Jerry L. Brown  
U.S. Patent No: 7,091,309  
Request for Reconsideration of Patent Term Adjustment

## **Exhibit A**

## PART B - FEE(S) TRANSMITTAL

DOCKETED

Complete and send this form, together with applicable fee(s), to: Mail

Mail Stop ISSUE FEE  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
or Fax (571) 273-2885

JAN 03 2006

INSTRUCTIONS: This form should be used for transmitting the ISSUE FEE and PUBLICATION FEE (if required). Blocks 1 through 5 should be completed where appropriate. All further correspondence including the Patent, advance orders and notification of maintenance fees will be mailed to the current correspondence address as indicated unless corrected below or directed otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate "FEE ADDRESS" for maintenance fee notifications.

CURRENT CORRESPONDENCE ADDRESS (Note: Use Block 1 for any change of address)

27128 7590 12/30/2005

BLACKWELL SANDERS PEPPER MARTIN LLP  
720 OLIVE STREET  
SUITE 2400  
ST. LOUIS, MO 63101

Note: A certificate of mailing can only be used for domestic mailings of the Fee(s) Transmittal. This certificate cannot be used for any other accompanying papers. Each additional paper, such as an assignment or formal drawing, must have its own certificate of mailing or transmission.

## Certificate of Mailing or Transmission

I hereby certify that this Fee(s) Transmittal is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the Mail Stop ISSUE FEE address above, or being facsimile transmitted to the USPTO (571) 273-2885, on the date indicated below.

electronic

Beth Hookway	(Depositor's name)
<i>Beth Hookway</i>	(Signature)
March 27, 2006	(Date)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/708,026

02/03/2004

Jerry L. Brown

73629-NEW

2025

TITLE OF INVENTION: PROCESS FOR THE MANUFACTURE OF TEMPERATURE-SENSITIVE POLYMERS

713629.414

APPLN. TYPE	SMALL ENTITY	ISSUE FEE	PUBLICATION FEE	TOTAL FEE(S) DUE	DATE DUE
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nonprovisional

NO

\$1400

\$300

\$1700

03/30/2006

EXAMINER	ART UNIT	CLASS-SUBCLASS
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TESKIN, FRED M

1713

528-503000

1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.363).

☐ Change of correspondence address (or Change of Correspondence Address form PTO/SB/122) attached.

☐ "Fee Address" indication (or "Fee Address" Indication form PTO/SB/47; Rev 03-02 or more recent) attached. Use of a Customer Number is required.

2. For printing on the patent front page, list

(1) the names of up to 3 registered patent attorneys or agents OR, alternatively,

(2) the name of a single firm (having as a member a registered attorney or agent) and the names of up to 2 registered patent attorneys or agents. If no name is listed, no name will be printed.

1 Blackwell Sanders  
Peper Martin LLP

2 \_\_\_\_\_  
3 \_\_\_\_\_

3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)

PLEASE NOTE: Unless an assignee is identified below, no assignee data will appear on the patent. If an assignee is identified below, the document has been filed for recordation as set forth in 37 CFR 3.11. Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE

(B) RESIDENCE: (CITY and STATE OR COUNTRY)

Solutia Inc.

St. Louis, MO

Please check the appropriate assignee category or categories (will not be printed on the patent): ☐ Individual ☒ Corporation or other private group entity ☐ Government

4a. The following fee(s) are enclosed:

☒ Issue Fee☒ Publication Fee (No small entity discount permitted)☐ Advance Order - # of Copies \_\_\_\_\_

4b. Payment of Fee(s):

☐ A check in the amount of the fee(s) is enclosed.☐ Payment by credit card. Form PTO-2038 is attached.☒ The Director is hereby authorized by charge the required fee(s), or credit any overpayment, to Deposit Account Number 11-0160 (enclose an extra copy of this form).

5. Change in Entity Status (from status indicated above)

☐ a. Applicant claims SMALL ENTITY status. See 37 CFR 1.27.☐ b. Applicant is no longer claiming SMALL ENTITY status. See 37 CFR 1.27(g)(2).

The Director of the USPTO is requested to apply the Issue Fee and Publication Fee (if any) or to re-apply any previously paid issue fee to the application identified above.

NOTE: The Issue Fee and Publication Fee (if required) will not be accepted from anyone other than the applicant; a registered attorney or agent; or the assignee or other party in interest as shown by the records of the United States Patent and Trademark Office.

Authorized Signature

*Mark F. Wachter*

Date

*March 27, 2006*

Typed or printed name

Mark F. Wachter

Registration No.

27,243

This collection of information is required by 37 CFR 1.311. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**Acknowledgement Receipt**

The USPTO has received your submission at **17:27:52** Eastern Time on **27-MAR-2006**.

No fees have been paid for this submission. Please remember to pay any required fees on time to prevent abandonment of your application.

**eFiled Application Information**

EFS ID	1012865
Application Number	10708026
Confirmation Number	2025
Title	PROCESS FOR THE MANUFACTURE OF TEMPERATURE- SENSITIVE POLYMERS
First Named Inventor	Jerry L. Brown
Customer Number or Correspondence Address	27128
Filed By	Mark F. Wachter/Beth Hookway
Attorney Docket Number	713629.NEW
Filing Date	03-FEB-2004
Receipt Date	27-MAR-2006
Application Type	Utility

**Application Details**

Submitted Files	Page Count	Document Description	File Size	Warnings
IssueFee713629414.pdf	1	Issue Fee Payment Recorded	191860 bytes	◆ PASS

This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

New Applications Under 35 U.S.C. 111

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

*If you need help:*

- Call the Patent Electronic Business Center at (866) 217-9197 (toll free) or e-mail [EBC@uspto.gov](mailto:EBC@uspto.gov) for specific questions about Patent e-Filing.
- Send general questions about USPTO programs to the [USPTO Contact Center \(UCC\)](#).
- If you experience technical difficulties or problems with this application, please report them via e-mail to [Electronic Business Support](#) or call 1 800-786-9199.